Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARIN KLOKKERS-BETHKE
and ULRICH MUNCH

Appeal No. 94-3564
Application 07/890,314[1]

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and GRON, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 16 through 24, which are all of the claims remaining in the application.

[1] Application for patent filed May 26, 1992. According to applicants, the application is a continuation of Application 07/731,126, filed July 15, 1991.

REPRESENTATIVE CLAIM

Claim 16, which is illustrative of the subject matter on appeal, reads as follows:

16. A medicinal product for the buccal administration of nitroglycerin to a patient in need of nitroglycerin therapy comprising:

a container having a pump spray means for dispensing a spray dosage of a composition in the container into the buccal area of a patient's mouth;

the composition being a hydrophilic aqueous pump spray composition comprising 0.15 to 0.50 weight/% of nitroglycerin, 24.50 to 24.85 weight/% of ethanol, 32.00 weight/% of 1,2-propyleneglycol and 43.00 weight/% of purified water and having a pH of 3 to 6; and

the composition and the container containing no propellant.

THE REFERENCES

In rejecting the appealed claims on prior art grounds, the examiner relies on three references. The first cited reference is European Patent Application 310,910 published April 12, 1989. We shall hereinafter refer to the European Patent Application by the name of its lead inventor, Aouda. The second reference is U.S. Patent No. 3,155,574 issued November 3, 1964, to Silson et al. (Silson).

In the Examiner's Answer, page 2, section (7), the examiner cites the third reference as follows: European Patent Application 3922650 published January 11, 1990. That citation is incorrect, which can be seen from a review of the Office Action mailed July 21, 1992, citing German Offenlegungsschrift DE 3922650 printed January 11, 1990. Manifestly, the reference to European Patent Application 3922650 in the Examiner's Answer constitutes an inadvertent error. Nevertheless, neither appellants nor the examiner has favored this record with an English translation of German Offenlegungsschrift DE 3922650. Both refer instead to the "equivalent" of DE 3922650, namely, U.S. Patent No. 5,047,230 issued September 10, 1991, to Nagy et al. based on Application Serial No. 376,678, filed July 7, 1989.[2] According to appellants,

> The cited Nagy reference [DE 3922650] is in German, but corresponds to U.S. Patent No. 5,047,230. Accordingly, unless otherwise indicated, further reference will be to the U.S. patent rather than to the German Nagy patent.

See the main Brief before the Board, page 3, last paragraph.

[2] DE 3922650 and U.S. Patent No. 5,047,230 derived from the same Hungarian priority document, number 3585/88 filed July 8, 1988.

Likewise, in responding to appellants' arguments on appeal, the examiner specifically refers to portions of U.S. Patent No. 5,047,230 by column and line. See the Examiner's Answer, page 4, last paragraph.

The only reasonable interpretation which these facts permit is that the third reference is U.S. Patent No. 5,047,230 issued September 10, 1991, to Nagy et al. That patent is based on Application Serial No. 376,678, filed July 7, 1989, and therefore constitutes legally available prior art under 35 USC § 103 via 35 USC § 102(e). In our review of this appeal, we have not considered the text of German Offenlegungsschrift DE 3922650 because the administrative record does not contain an English translation thereof. Our review is based entirely on a consideration of U.S. Patent No. 5,047,230, hereinafter referred to by the name of its lead inventor, Nagy.

THE ISSUE

The issue presented for review is whether the examiner erred in rejecting claims 16 through 24 under 35 USC § 103 as unpatentable over the combined disclosures of Aouda, Silson, and Nagy.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials:

(1) The instant specification, including all of the claims on appeal;

(2) Appellants' main Brief and Reply Brief before the Board;

(3) The Examiner's Answer and the office actions referred to therein, specifically, Paper No. 10 mailed July 21, 1992, and Paper No. 15, mailed May 18, 1993;

(4) The communication mailed by the examiner July 7, 1994 (Paper No. 25);

(5) The Aouda, Silson, and Nagy references relied on by the examiner; and

(6) The Lang Declaration, filed under the provisions of 37 CFR § 1.132, executed January 12, 1993.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 USC § 103.

DISCUSSION

Each independent claim on appeal recites a container having a hydrophilic aqueous pump spray composition therein, where the composition comprises four ingredients in specified amounts. The composition comprises 0.15 to 0.50 weight/% of nitroglycerin, 24.50 to 24.85 weight/% of ethanol, 32.00 weight/% of 1,2-propyleneglycol and 43.00 weight/% of purified water and has a pH of 3 to 6. In our judgment, the prior art references relied on by the examiner are insufficient to support a conclusion of obviousness of claims containing those limitations.

The examiner argues that it would have been obvious to add propyleneglycol, per the teachings of Silson and Nagy, to the nitroglycerin spray of Aouda. According to the examiner, that proposed modification of Aouda would have led a person having ordinary skill in the art to the subject matter sought to be patented in claims 16 through 24. We disagree.[3]

First, each claim on appeal recites a hydrophilic aqueous pump spray composition containing 32.00 weight/% of 1,2-propyleneglycol. The examiner has not established that Silson discloses that amount of propyleneglycol. Having reviewed the

[3] The examiner sets forth the statement of rejection in the Office Action mailed July 21, 1992 (Paper No. 10), pages 2 and 3. In the Examiner's Answer, page 3, first paragraph, the examiner states that "[t]he claims are rejected for the reasons of record as stated in paragraph 16 of the office action mailed July 21, 1992".

Silson patent in its entirety, including column 1, line 71 through column 2, line 12, and Examples 1 through 12, we find that Silson discloses far less than 32.00 weight/% of propyleneglycol. The examiner has not pointed to any specific portion or portions of Silson which would have led a person having ordinary skill to the claimed subject matter, including a hydrophilic aqueous pump spray composition containing 32.00 weight/% of 1,2-propyleneglycol. For this reason, the combined disclosures of Aouda and Silson, regardless how viewed, are insufficient to support a conclusion of obviousness of the claimed subject matter.

Second, Nagy discloses an aerosol composition comprising nitroglycerin as active ingredient which contains 10 to 49% by weight of a C_{2-8} alcohol comprising two or three hydroxy groups, e.g., propyleneglycol. The range 10 to 49% "reads on" 32.00 weight/% of 1,2-propyleneglycol recited in the claims on appeal. However, Nagy also discloses 51 to 90% by weight of a C_{2-4} aliphatic alcohol, e.g., ethyl alcohol. In column 4, lines 3 through 16, Nagy stresses the importance of using a relatively high alcohol concentration ("the alcoholic solution having high alcohol concentration...is directly miscible with saliva, and this results in a better and quicker adsorption of the active

ingredient"; "the high alcohol concentration results in local hyperaemia, which also leads to a better and quicker resorption"). In contrast, each independent claim on appeal recites a hydrophilic aqueous pump spray composition containing 24.50 to 24.85 weight/% of ethanol. We disagree that a person having ordinary skill would have found it obvious to modify Aouda's nitroglycerin spray by adding 32.00 weight/% of propyleneglycol from the range set forth by Nagy, but refrain from using 51 to 90% by weight ethyl alcohol which Nagy requires. As stated in In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-302 (CCPA 1972), quoting from In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965),

> It is impermissible within the framework of section 103 to pick and choose from any one reference [Nagy] only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

We believe that this has been done here. In our judgment, therefore, the combined disclosures of Aouda and Nagy are insufficient to support a conclusion of obviousness of the claims on appeal.

Without the benefit of appellants' disclosure as a

blueprint, we find that the cited prior art provides no suggestion which would have led a person having ordinary skill from "here to there", i.e., from the nitroglycerin spray of Aouda to the claimed subject matter. Ex parte Tanksley, 37 USPQ2d 1382, 1386 (BPAI 1994). We have no doubt that the prior art could be modified in such manner to arrive at the subject matter defined in claims 16 through 24. The mere fact, however, that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). That is not the case here. Accordingly, we reverse the § 103 rejection set forth by the examiner.

Having carefully reviewed Aouda, Silson, and Nagy, we conclude that the examiner has not established a prima facie case of obviousness of claims 16 through 24. Accordingly, we find it unnecessary to discuss the Lang declaration which is relied on by appellants as rebutting any such prima facie case.

CONCLUSION

For the reasons set forth in the body of this opinion, we reverse the examiner's rejection of claims 16 through 24 under 35

USC § 103 as unpatentable over the combined disclosures of Aouda, Silson, and Nagy.

REVERSED

SHERMAN D. WINTERS Administrative Patent Judge	)
WILLIAM F. SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
TEDDY S. GRON Administrative Patent Judge	)

MARSHALL, O'TOOLE, GERSTEIN, MURRAY
& BORUN
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402